

REMARKS

Restriction Requirement

The Office has set forth a restriction requirement. In particular, the Office requires Applicants to elect one of the following groups:

- (I) Claims 28-37, only drawn to a method of creating a transgenic plant comprising a DNA molecule encoding an acidically modified nucleic acid binding protein containing an N-terminal extension of acidic amino acid residues (class 800, subclass 278), and
- (II) Claims 28-56, only drawn to a method of creating a transgenic nonhuman animal comprising a DNA molecule encoding an acidically modified nucleic acid binding protein containing an N-terminal extension of acidic amino acid residues, and drawn to transgenic nonhuman dominant negative polynucleotide sequence and method of producing said transgenic mammal (class 800, subclasses 14 and 21).

Election in Response to Restriction Requirement

Applicants hereby elect, with traverse, the claims of Group II (i.e., claims 28-56).

Discussion of the Restriction Requirement

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, *and* (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*" (M.P.E.P. § 803, emphasis added).

In the case at hand, the Office fails to meet the above-identified criteria and to present the required supporting evidence and reasoning. There is significant overlap in subject matter between the Groups (I) and (II), such that references considered during the examination of the claims of one group would be considered during the examination of the claims of the other group. For example, a search of the prior art for references relevant to an acidically modified nucleic acid binding protein containing an N-terminal extension of acidic amino acid residues (e.g., an acidically modified bZIP protein) could be relevant to both Groups I and II. In this regard, Applicants point out that the claims of Groups (I) and (II) are classified

In re Appln. of Vinson et al.
Application No. 10/059,720

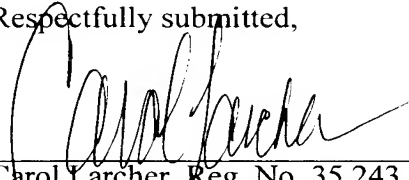
in the same class. This is not to say that the claims stand or fall together. Rather, the overlap in the relevance of references and the overlap in the classification of the claimed subject matter suggests that there is no need for a restriction requirement.

Thus, the Office has failed to meet the criteria for a proper requirement for restriction. Applicant respectfully submits that the requirement for restriction is improper and should be withdrawn.

Conclusion

Under the circumstances, Applicants request the withdrawal of the restriction requirement and consideration of other of the pending claims in addition to those of elected Group II. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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